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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,931	02/25/2004	Masanobu Torii	1506.1040	9585

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EXAMINER	
NAQI, SHARICK	

ART UNIT	PAPER NUMBER
3736	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ED

Office Action Summary	Application No.	Applicant(s)	
	10/784,931	TORII ET AL.	
	Examiner	**Art Unit**	
	Sharick Naqi	3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 March 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The amendment filed on March 16, 2007 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "concrete values" in claim 1 line 12, is a relative term, which renders the claim indefinite. The term "concrete values" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Examiner has interpreted the claim in a manner that would render the prior art applicable. Correction is required.

The term "influence degree" in claim 1 line 14 is a relative term, which renders the claim indefinite. The term "influence degree" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Examiner has interpreted the claim in a manner that would render the prior art applicable. The inventor needs to better define the use of this term.

The term “substantially” in claim 4 line 1 is a relative term, which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Use of this word renders the claim indefinite.

The term “similar” in claim 5 line 10 is a relative term, which render the claim indefinite. The term "similar" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. A clear explanation of the use of these terms is needed.

The term “maximum degree of similarity” in claim 1 line 4 and claim 5 line 14 is a relative term, which render the claim indefinite. The term “maximum degree of similarity” are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. A clear explanation of the use of these terms is needed.

Any claim dependent from a rejected claim is rejected due to its dependency upon said rejected claim.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "influence degree" in new claim 8 line 1 is a relative term, which renders the claim indefinite. The term "influence degree" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Examiner has interpreted the claim in a manner that would render the prior art applicable. The inventor needs to better define the use of this term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being unpatentable by Potter et al. USPN 4,733,354 ("Potter")

Claims 1-5 and 7 are rejected on substantially the same basis. Regarding non-amended claims and/or amendments not based on the applied prior art, see previous office action for details of the rejected.

Claim 8. (New) A diagnostic support method, comprising:

calculating, for every value in a case database, an influence degree of the value contributing to determination of disease name; (fig 1-16, column 2, lines 6-9 and lines 22-46) and

calculating, for a new patient, a degree of similarity by weighing, with a new patient data field influence degree, a difference between each field of existing case data and a corresponding new patient data field. (fig 1-16, column 2, lines 6-9 and lines 22-46)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Potter), and further in view of Iliff USPN 5,935,060 ("Iliff").

Claims 6 is rejected on substantially the same basis. Regarding non-amended claims and/or amendments not based on the applied prior art, see previous office action for details of the rejected.

Response to Arguments

Applicant's arguments filed March 16, 2007 have been fully considered but they are not persuasive.

Claims 1-6 and 8 are rejected because they are indefinite. See the above 35 U.S.C. 112, second paragraph rejection above. One example is the term "concrete

values" in claim 1, line 12. Applicant states concrete is numerical in page 1, lines 18 of the Applicant's Arguments/Remarks. However, this is not consistent with the specification. The specification states, in page 16 lines 24-27 and page 17, lines 1-14, the following:

In next step s03, the CPU 10 eliminates noise data. To be ***concrete****, the CPU 10 compares, for every record generated in s02, the examination values in the respective fields in the concemed record with upper and lower limit values (the values that are too high and too low to be plausible as far as the examinee is alive) prepared beforehand in relation to the respective items. The CPU 10 eliminates, as the noise data, the examination values that do not fall in between the upper and lower limit values corresponding thereto. Further, the CPU 10 compares, for every record, the examination values in the respective fields in that record with the examination values in the same fields in other records, and eliminates as the noise data the examination values that obviously prove to be peculiar as compared with other records [Emphasis Added].*

This paragraph is an apparent definition for concrete. However, the paragraph is indefinite as to the exact definition of concrete. Taken literally the entire paragraph could be the definition. However, using that definition in the claim makes the claim incoherent.

Applicant's definition is also inconsistent with the dictionary definition of concrete: naming a real thing or class of things (Merriam-Webster's Online Dictionary). As such the claim is indefinite. Examiner has used the broadest reasonable interpretation to reject the claims.

The preceding explanation is representative of the remaining rejections under 35 U.S.C 112, second paragraph.

Applicant argues that the prior art does not meet the limitation, "calculates a degree of similarity...by weighing a difference between a value in each field of the case data and a value in its corresponding field of the new patient data with influence degree of that value in the new patient data" recited in claim 1 at lines 11-15. The Examiner disagrees with the Applicant's position. Examiner has used the broadest reasonable interpretation to determine the metes and bounds of the claims. As previously stated, the use of the term "influence degree" in the claim limitation and the use of "concrete values", claim 1, line 11 renders the claim indefinite. Examiner has determined that the claim is referring to system performing a differential diagnosis and has applied the prior art in a manner sufficient to reject it.

Examiner disagrees with the Applicant's interpretation that the retrieving, presenting, selecting and entering of Potter et al. is a mechanical process that does not involve any calculation because the process of Potter et al. is part of a differential diagnosis performed by the computer processor (column 2, lines 14-20), therefore, it is sufficient to meet the claim limitation.

The other independent claims are similarly rejected on substantially the same basis

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharick Naqi whose telephone number is 571-272-3041. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SN
June 21, 2007

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